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REMARKS

Claims 1-8, 10, 32-41, and 52-63 are currently pending in the application. By this amendment, claims 1, 32, 52, 56 and 58 are amended and claims 59-63 are added for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided at pages 4, 5, 9, 12, and 14-16 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Examiner Interview

Applicants appreciate the courtesies extended by the Examiner during the telephonic interview with Applicants' representative, which was conducted on January 12, 2009. During the interview, the rejection of claim 1 under 35 U.S.C. § 101 as well as the rejections of 1-10, 32, and 52 under 35 U.S.C. § 103(a) were discussed. The Examiner made suggestions on how to overcome the rejection of claim 1 under 35 U.S.C. § 101. These suggestions are incorporated herein.

Claim Objections

The Examiner has objected to claim 58 for having a typographical error. To advance prosecution, Applicants have amended claim 58. Accordingly, Applicants request the objection of claim 58 be withdrawn.

35 U.S.C. §101 Rejection

Claims 1-8, 10, and 53-58 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Although Applicants believe claim 1 is statutory, Applicants have nonetheless amended claim 1 to advance prosecution. Applicants submit that claim 1, as amended, positively recites the statutory class to

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which the method is tied. Moreover, in accordance with the Examiner's recommendations, claim 1 has been amended to include the statutory class at the beginning of the recommended claim elements. Accordingly, Applicants respectfully request the rejection of claim 1 be withdrawn. Moreover, Applicants submit that claims 2-8, 10, and 53-58 are dependent claims and are allowable based on their dependency on independent claim 1.

35 U.S.C. §103 Rejection

Claims 1-8, 10, 32-41, and 52-58 were rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent Publication No. 2002/0198727 issued to Ann, *et al.* ("Ann") in view of U.S. Patent Publication No. 2003/0158800 issued to Pisello, *et al.* ("Pisello") and in further view of "Enterprise Integration Modelling: A Review of Theory and Practice" by Patankar ("Patankar"). This rejection is respectfully traversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d

¹ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, --- U.S. ---, 127 S.Ct. 1727, 1731 (2007)).

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1438 (Fed. Cir. 1991). See MPEP §2142. Applicants submit that no proper combination of the applied art teaches or suggests each and every feature of the claimed invention.

Claims 1, 32, and 52

Claim 1 recites, in pertinent part:

... using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels...

Claim 32 recites, in pertinent part:

... a means for storing a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels...

Claim 52 recites, in pertinent part:

... a seventh computer code to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels.

Applicants submit that none of Ann, Pisello, nor Patankar disclose the feature of using a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels. Specifically, Ann includes an enterprise architecture with business and information technology components and defined linkages between them, which allow for the impact of changes in one component to drive the other component. (Paragraph [0006].) For example, the business defines strategic directions, which deliver strategies to capabilities. The capabilities drive the principles, which in turn control the capabilities. The enterprise

technology framework and application software, which are part of the IT framework, are used to provide a framework based on the principals. This is done in part by using processes from the business architecture, which enable the capabilities. (See paragraphs [0041] – [0046] for a further explanation of the relationships in FIG. 5.)

Accordingly, Ann provides an enterprise framework, however, there is no indication that this enterprise framework is hierarchical. Moreover, even if the framework were hierarchical, which Applicants do not concede, Applicants submit that there is no indication that the hierarchy has a plurality of levels or that any of the levels have dynamic links. Furthermore, even assuming *arguendo* that Ann were to include dynamic links, which Applicants do not concede, Ann provides no indication that the dynamic links would differ between the plurality of levels. Accordingly, Applicants submit that Ann fails to use a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels.

Applicants further submit that Pisello does not use a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels. Rather, Pisello is directed to financially evaluating information technology (IT) projects. (Paragraph [0002].) To do this, Pisello uses a number of input templates that are used to collect data from a user. This information may relate to IT projects, peer organizations, and/or budgetary goals. (Paragraphs [0024]-[0026] and [0030].) The inputted information is accumulated and indices for an IT project are calculated and presented to a user in a report. (Paragraphs [0048] and [0091].)

Thus, Pisello allows a user to input data and produces a report on how the inputted data may affect the organization's finances. However, Pisello provides no indication that the input templates or any other feature in Pisello includes a hierarchical

relationship of a goal, the value, the at least one capability, and a resource. Moreover, even if Pisello were to include a hierarchical relationship, which Applicants do not concede, there is no indication that the hierarchical relationship has a plurality of levels. Furthermore, there is no indication that Pisello includes one or more dynamic links that differ between the plurality of levels. Accordingly, Applicants submit that Pisello does not use a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels.

Patankar also fails to disclose the use of a database to store a hierarchical relationship of a goal, the value, the at least one capability, and a resource, the hierarchical relationship having a plurality of levels with one or more dynamic links that differ between the plurality of levels. Instead, Patankar provides a theoretical enterprise integration model (EIM). (Abstract.) Patankar explains that an EIM is an abstraction of an enterprise that is capable of supporting decision making across functional boundaries within an enterprise. Enterprise integration is used to attempt to improve the performance of the enterprise by managing interactions among participants in complex organizations. (Page 21.) This may be performed by providing a framework to suggest a migration path from a current organization system to a new system. (Page 22.)

Patankar provides an illustrative EIM in the form of a CIM-OSA architecture having enterprise system building blocks and physical system building blocks. The CIM-OSA architecture describes the enterprise from different viewpoints, which include a function view, an information view, a resource view, and an organizational view. The building blocks used in the CIM-OSA architecture may be generic, partial, or particular. The blocks may further be requirement, specification, or implementation related. (Figure 7, pages 28 and 29.) However, Patankar does not indicate that the blocks are hierarchical and also fails to disclose that the blocks are related to a goal, the value, the at least one capability, and a resource. Moreover, even *arguendo* that these features

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were disclosed, which Applicants do not concede, Applicants submit that the Patankar is a structured enterprise that lays the foundation for a system and does not include one or more dynamic links that differ between the plurality of levels. Accordingly, Applicants submit Patankar fails to teach at least this feature of claims 1, 32, and 52. As Ann, Pisello, and Patankar fail to disclose all of the feature of the claimed invention, Applicants respectfully submit that claims 1, 32, and 52 are not obvious and request the rejection of claims 1, 32, and 52 be withdrawn.

Dependent Claims

Claims 2-8, 10, 33-41, and 53-56 are dependent claims, depending from distinguishable independent claims 1 and 32, respectively. For these reasons, Applicants submit that these claims are allowable for at least the reasons discussed above with respect to independent claims 1 and 32. Moreover, Applicants submit that these claims include additional subject matter that is allowable. Accordingly, Applicants respectfully request the rejection of claims 2-8, 10, 33-41, and 53-56 be withdrawn.

Claim 2 and 34

Claim 2 recites, in pertinent part:

... comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value.

Claim 34 recites, in pertinent part:

... a component to compare the value provided by the at least one capability with a value provided by at least one other capability and to determine which capability provides optimum value.

Applicants agree with the Examiner's assertion on page 11 of the Office Action that Ann does not disclose comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which

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capability provides optimum value. However, the Examiner is of the opinion that this feature is disclosed by Pisello. Applicants disagree. Rather, Pisello is directed to financially evaluating information technology projects. (Paragraph [0002].) Pisello does this via a software module that accepts input about an organization from users. (Paragraph [0024].) This input may include information about an organization's base case financials and information about an organization's projects.

Pisello allows the user to select budget analysis templates, which summarize the information and presents the inputted information to a user in a report. (Paragraph [0091].) However, Applicants submit that the mere summarization and presentation of inputted information in a report is not the same as comparing a value provided with a capability with a value provided by another capability. Moreover, even if the creation of a report did constitute a comparison, which Applicants do not concede, Applicants submit that Pisello does not determine which capability provides an optimum value. Rather, it is the IT executive that selects a project that he or she expects to be optimal, regardless of whether the project is actually optimal. (Paragraph [0008].) Therefore, Applicants submit that neither Ann nor Pisello compare the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value. Accordingly, Applicants respectfully request the rejection of claim 2 be withdrawn.

Claims 5, 8, 37, and 40

Claim 5 recites, in pertinent part:

... assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight.

Claim 8 recites, in pertinent part:

... assigning a weight to the at least one capability; and prioritizing the at least one capability based on the assigned weight.

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Claim 37 recites, in pertinent part:

... a component to assign a weight to the one or more strategic resources and a component to prioritize the one or more resources based on the assigned weight.

Claim 40 recites, in pertinent part:

... a component to assign a weight to the at least one capability;
and
a component to prioritize the at least one capability based on the assigned weight.

The Examiner recognizes that Ann does not assign a weight to the at least one capability and does not prioritize the at least one capability based on the assigned weight. The Examiner, however, is of the opinion that Pisello discloses this feature. Applicants disagree. Instead, Pisello discloses an IT cost template that allows a user to input IT costs for a project. (Paragraph [0034].) Pisello also includes a business unit cost template, which collects information from a user about a project's costs. (Paragraph [0038].) Pisello further includes a key performance indicator (KPI) template, which allows the user to input information regarding a KPI attached to a project being analyzed. (Paragraph [0041].) Pisello explains that the user may input values into the IT cost template or and the benefits template using a worksheet. (Paragraph [0040].)

Applicants assert that merely inputting data into a template is not the same as assigning a weight to one or more strategic resources. Similarly, merely inputting data is not the same as prioritizing the one or more strategic resources based on the assigned weight. Accordingly, Applicants submit that Pisello does not assign a weight to the one or more strategic resources and prioritize the one or more strategic resources based on the assigned weight. As such, Applicants respectfully request the rejection of claims 5, 8, 37, and 40 be withdrawn.

Claims 6, 7, 10, 38, 39, 41, and 55

Claim 6 recites, in pertinent part:

... assigning outcome based performance metrics to the one or more strategic resources.

Claim 7 recites, in pertinent part:

... implementing the one or more strategic resources and tracking the one or more strategic resources based on the outcome based performance metrics.

Claim 10 recites, in pertinent part:

... assigning outcome based performance metrics to the at least one capability; and
implementing the at least one capability and tracking the at least one capability based on the outcome based performance metrics.

Claim 38 recites, in pertinent part:

... a component to assign outcome based performance metrics to the one or more strategic resources.

Claim 39 recites, in pertinent part:

... a component to track the one or more strategic resources based on the outcome based performance metrics.

Claim 41 recites, in pertinent part:

... a component to assign outcome based performance metrics to the at least one capability.

Claim 55 recites, in pertinent part:

... wherein the outcome based performance metrics are defined and tested by conducting facilitated working sessions or building simulation models.

Applicants agree with the Examiner that Ann does not assign outcome based performance metrics. However, Applicants disagree with the Examiner's assertion that Pisello makes up for the deficiencies of Ann. Specifically, Pisello discloses key

performance indicators (KPIs), which are used to define and measure improvement in IT. For example, KPIs may measure customer satisfaction rankings, responsiveness, or innovation. (See Paragraphs [0041]-[0047].)

Pisello allows KPIs to be inputted or removed by a user using a KPI template. Specifically, the KPI template allows a user to input information related to an intangible business operating efficiency benefit. This information may include the name of the intangible benefit, person hours, calls, minutes, hours, tasks, etc. (See Paragraphs [0041]-[0047].) An intangible benefit analysis template summarizes the KPIs according to intangible benefits - IT, intangible benefits - operating efficiency, and/or intangible benefits - strategic. (Paragraph [0058].) Thus, Pisello allows users to input information into a KPI template, which can later be summarized by the intangible benefit analysis template. However, the inputted information is not outcome based. To the contrary, the user does not know the outcome of the projects and would not need the KPI templates if the user did know the outcome of the projects. Accordingly, Applicants submit that Pisello fails to assign outcome based performance metrics

Applicants further agree with the Examiner that the combination of Ann and Pisello fail to explicitly disclose tracking the at least one capability based on the outcome based performance metrics. However, to the extent that the Examiner has used Official Notice to show the tracking feature of the claimed invention, Applicants remind the Examiner that MPEP 2144.03 specifically explains that "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." Accordingly, Applicants respectfully request that the Examiner produce documentary evidence to support the Examiner's assertions of official notice.

For at least the forgoing reasons, Applicants respectfully request the rejection of claims 6, 7, 10, 38, 39, 41, and 55 be withdrawn.

Official Notice of Claims 7, 10, 55, 57, and 58

The Examiner takes official notice in claims 7, 10, 55, 57, and 58 that "it is well-known in the business management arts at the time of the invention was made to track performance, for example using KPI." Applicants respectfully disagree and remind the Examiner that MPEP 2144.03 specifically explains that "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." Accordingly, Applicants respectfully request that the Examiner produce documentary evidence to support the Examiner's assertions of Official Notice.

MPEP 2144.03 states:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

...

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Improper rejection of claim 35

Claim 35 recites, in pertinent part:

... wherein the enterprise architecture includes at least one of a hardware architecture and a software architecture.

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The Examiner has rejected claim 35 on page 15 of the Office Action under a similar rationale as claims 1-10. However, Applicants submit that the features of claim 35 have not been disclosed in any of claims 1-10. Accordingly, Applicants submit that the Examiner has failed to address the features of claim 35 and, as such, a clear issue was not developed between the Examiner and Applicant. Therefore, the next Office Action, which should clarify this issue, *cannot* be made final.

According to MPEP 706,

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicants respectfully submit that the Examiner may not make the next action final as in the previous Office Action a "clear issue [was not] developed between the examiner and applicant."

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Other Matters

Claims 59-63 are added for the Examiner's consideration. Applicants submit that claims 59-63 contain allowable subject matter. Moreover, no combination of the applied references teach or suggest the features of claims 59-63.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', written over a horizontal line.

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